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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

John Eckl

Attorney Docket No.: F-278

Serial No.: 09/903,500

Group Art Unit: 3622

Filed: July 12, 2001

Examiner: Myhre, James W.

For: BILLING SYSTEM WITH
ELECTRONIC AND PRINTED
DISTRIBUTION

Date: January 30, 2003

Patricia Lewis
#10/Appellant's
Brief Wym
2-03-03

APPELLANT'S BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231
Sir:

The appellants respectfully submit the following brief in the appeal of the subject application. The Notice of Appeal was filed on November 1, 2002, following a Final Office Action mailed August 1, 2002.

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to:
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Mariene Olphonc
Name of Representative
Reg. No. 46,650

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Signature

January 30, 2003
Date

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02 FC:1402 320.00 CH

I. Real Party In Interest:

Pitney Bowes Inc., a Delaware corporation having its principal place of business in Stamford, Connecticut, is the real party in interest by way of assignment from the applicants.

II. Related Appeals And Interferences:

Some related issues are currently under appeal in application 09/289,901 titled ROUTER INSTRUCTION PROCESSOR FOR A DIGITAL DOCUMENT DELIVERY SYSTEM (Attorney Docket E-817) for which a Notice of Appeal was filed on August 28, 2002, an Appeal Brief was filed on October 28, 2002, an Examiner's Answer was mailed on January 14, 2003, and for which a Reply Brief will likely be filed in the near future.

III. Status Of The Claims:

- (1) Claims 12 and 14-36 are the subject of this Appeal, and stand rejected.
- (2) Appellants hereby appeal the rejection of claims 12 and 14-36.

IV. Status Of The Amendments:

(1) The present application is a continuation of application 08/772,293 filed December 23, 1996. A preliminary amendment was filed with this continuation canceling all of the original eleven claims and adding new claims 12-36. In response to a February 7, 2002 Office Action, applicants canceled claim 13 and amended claims 12, 16, 18, and 27-29.

A final Office Action was mailed on August 1, 2002. A Notice of Appeal was filed on November 1, 2002.

- (2) **Appendix A**, attached hereto, contains current claims 12 and 14-36.

V. Summary Of The Invention:

The appealed claims are directed to a method and apparatus for delivering billing statements from a biller to a recipient by means of a printed or electronic transmission. (Page 2, lines 1-3). The method of transmission is determined based on the preferences of the recipient. (Page 4, lines 2-16). In one embodiment, a billing server receives billing information from the biller's computer. (Page 3, lines 12-23). Based on the stored recipient preferences, the billing server determines whether the billing information is intended for printed or electronic transmission. (Page 4, 2-20). A printer is connected to the billing server to generate a printed billing statement from the billing information. (Page 3, lines 12-18).

An electronic information server is also connected to said billing server. The electronic information server converts billing information so that it is suitable for electronic transmission and generates electronic billing statements from the billing information. (Page 4, lines 13-16). The electronic information server electronically transmits the electronic billing statement to the recipient over a communications network. (Page 4, lines 13-27).

To properly direct the billing information for either printed or electronic delivery, a routing means coupled to the billing server routes the billing information to the printer if the billing statement is determined to be transmitted by printed transmission. (Page 3, lines 19-25). Similarly, billing information is routed to the electronic information server if the billing statement is determined to be transmitted by said electronic transmission. (Id.) For determining routing of billing information, a lookup table is coupled to said billing server. (Page 4, lines 2-17). The lookup table contains delivery preferences of bill recipients. (Id.) The routing means routes the billing information in accordance with stored delivery preferences. (Page 3, lines 19-25).

This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Issues:**The Rejections**

Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,802,498 to Comesanas ("Comesanas"). Claims 16, 24, 28, and 35 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Comesanas in view of U.S. Patent 5,699,528 to Hogan ("Hogan").

Issue for Appeal

Do the asserted references satisfy the rule that each of the claimed elements must be disclosed or suggested in the asserted reference in order to satisfy obviousness under 35 U.S.C. § 103? In particular, do the asserted references include the steps and elements relating to utilization of recipient delivery preferences in processing of billing statements?

VII. Grouping Of Claims:

Claims 12 and 14-36 stand and fall together.

VIII. The Argument:

To establish a proper case of obviousness under § 103(a), the Examiner must make a *prima facie* showing that the prior art contains some teaching or suggestion of, or motivation for, all the elements of the claimed invention. Thus, it is well settled that the Examiner "bears the initial burden ... of presenting a *prima facie* case of unpatentability." In re Plasecki, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

A. *Rejections based solely on Comesanas*

Because the prior art of record fails to show, and the Examiner failed to treat all the features of the appealed claims, the rejections of the claims was improper. In particular, the asserted references do not disclose or suggest the features relating to "delivery preferences" as recited in each of the independent claims (12, 18, 21, 26, and 30). The Examiner has misconstrued a feature described in Comesanas, whereby an invoice recipient chooses whether to authorize pre-payment of return transmittal charges, to read on a method and system utilizing recipient "delivery preferences" whether to receive billing statements by physical or electronic delivery means.

The relevant portions of the of the rejected independent claims read as follows:

Claim 12 - "lookup table containing delivery preferences for the at least one recipient indicating whether a billing statement is to be transmitted by a said printed transmission or electronic transmission, said routing means routing billing information in accordance with said delivery preferences;"

Claim 18 - "prescribing delivery preferences for said billing information" and "associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;"

Claim 21 - "means for extracting from a database the prescribed delivery preference corresponding to each said isolated record" and "means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;"

Claim 26 - "extracting from a database the prescribed delivery preference corresponding to each said isolated record" and "determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference."

Claim 30 - "a server coupled to said switch, said server comprising: means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon the prescribed delivery preference of the corresponding recipient; means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information."

These missing claim elements relate to using the customer prescribed "delivery preference" in order to select printed or electronic delivery techniques.

In contrast, Comesanas is directed towards a system by which a customer can pre-authorize return transmittal charges to be added to charges in an invoice. For example, upon such pre-authorization, a biller can include a pre-paid return envelope with a bill, and a charge for the return envelope will be included in the invoice. This pre-authorization feature of Comesanas fails to satisfy the "delivery preference" elements recited in the rejected independent claims because it has nothing to do with a delivery preference for electronic or printed delivery.

Applicant does not dispute that Comesanas identifies both mail and electronic transmittal as potential means of delivery for invoices. However, that reference includes no description or suggestion of a recipient preference as playing a part in determining which method of delivery is used. For example, in describing an alternative to pre-paid return envelopes, Comesanas states:

[I]n the future, it is contemplated for transmittal of invoices and invoice payments to be accomplished electronically and for the existence of transmittal charges for such electronic transmittal. The present invention can be used in an **all-electronic** business environment whereby, for the debtors convenience in being allowed to make return payments electronically, the debtor signs a print written agreement that he authorizes being billed on his or her invoice for electronic transmittal charges that would otherwise be incurred by the creditor for such electronic return payments for which the creditor would be unwilling to pay.

Col. 3, lines 13-24, emphasis added.

In Comesanas' description of electronic transmittal being an alternative to paper mail transmittal, there is no description or indication that invoice recipients have an opportunity to express preferences of whether to receive bills by electronic or printed transmission. As a further result, there is no description or suggestion that such preferences be stored and acted upon as part of the processing of billing statements, as per the rejected independent claims. In Comesanas, an "all-electronic business environment" (Col. 3, line 17) is only generally described as an alternative to paper transactions. Recipient preferences for choosing between printed or electronic delivery are never mentioned or suggested.

To overcome these shortfalls, the Examiner's best argument is that Claim 3 of Comesanas, at Col. 4, lines 50-52, states the step of "determining whether each of said invoices is to be sent electronically or by mail." Other than the specification's speculation that electronic delivery might one day replace physical mail, this claim step is not discussed in the body of Comesanas. In particular, nowhere does Comesanas describe or suggest that such determining step is based on recipient preferences, or that such preferences be variously stored, retrieved, and acted upon, as more specifically recited in the rejected independent claims. This broad concept of having two potential modes of transmittal does not disclose or suggest the specific steps and elements for utilizing recipient delivery preferences as recited in the rejected claims.

The Examiner may attempt to rely on Comesanas' description of the debtor's choice of whether to authorize the pre-payment of transmittal charges, as satisfying the missing claim elements. For example, again in Claim 3 of Comesanas, at Col. 4, lines 44-47, a step of "determining whether each of said selected debtors has signed an agreement to pay transmittal charges for return payment and if such an agreement was signed," is recited. This determination in Comesanas has nothing to do with implementing a recipient's preference as to printed or electronic delivery, only whether transmittal charges for return payment is authorized. There is no indication anywhere in

Comesanas that the debtor is allowed to express a preference of printed or electronic transmission.

A choice of transmission method and a choice of prepaid return transmittal charges are conceptually independent, and the availability of one does not necessitate the presence of the other. In contrasting the two "determining" steps discussed above with regard to Claim 3 of Comesanas, it can be seen that the debtors role in selecting whether to include a pre-paid return transmittal is expressly stated. This contrasts with the "determining" step relating to electronic or mail transmittal where there is no mention of the debtor. Under principles of differentiation, it is clear that the steps of Claim 3 in Comesanas include no suggestion that the debtor should be involved in choosing transmittal means, and that the steps and elements recited in the present application are not satisfied. Any such suggestion of a connection by the Examiner is not supported and is constructed wholly from impermissible hindsight in view of the now apparent merits of Applicant's invention.

Accordingly, it is respectfully submitted that the rejections of independent claims 12, 21, 26, and 30 and their respective dependent claims in view of Comesanas should be overturned.

B. *Rejections Based on Comesanas in View of Hogan*

Claims 16, 24, 28, and 35 stand rejected as being unpatentable over Comesanas in view of Hogan. As discussed above, the claims of the present application recite the selection of printed or electronic transmittal based on prescribed customer preferences, a feature not described or suggested by Comesanas.


Hogan describes an electronic billing system including various features, but that fails to describe or suggest the features noted above as missing from Comesanas. In particular, Hogan does not include recipient preferences for printed or electronic delivery. The Examiner does not assert that Hogan includes the missing features

identified above, but cites that reference in relation to claim elements that are not part of this appeal. Accordingly, Hogan does not cure the defects of Comesanas described above and claims 16, 24, 28, and 35 should be allowable for the same reasons.

IX. Conclusion:

For the reasons advanced above, the Appellant respectfully submits that claim 12 and 14-36 are patentable. Reversals of the rejections by the Examiner are respectfully solicited.

Respectfully submitted,


Michael J. Cummings
Reg. No. 46,650
Attorney for Appellants
Telephone (203) 924-3934

Application Serial Code No.: 09/903,500

BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION

APPENDIX A TO APPELLANT'S APPEAL BRIEF

Current Copy of the Claims

12. A billing system for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising:

a billing server coupled to a biller's computer operative to receive billing information from said biller's computer and determine whether said billing information is intended for said printed transmission or said electronic transmission;

a printer operably connected to said server operative to generate a printed billing statement from said billing information;

an electronic information server operably connected to said billing server, said electronic information server operative to convert said billing information for electronic transmission and generate an electronic billing statement from said billing information and electronically transmit the electronic billing statement to the at least one recipient over a communications network;

routing means coupled to said billing server for routing said billing information to said printer if said billing statement is determined to be transmitted by said printed transmission and to said electronic information server if said billing statement is determined to be transmitted by said electronic transmission; and

a lookup table coupled to said billing server, said lookup table containing delivery preferences for the at least one recipient indicating whether a billing statement is to be transmitted by a said printed transmission or electronic transmission, said routing means routing billing information in accordance with said delivery preferences.

14. A billing system as recited in claim 12 wherein the biller's computer contains billing information for a plurality of recipients and the billing server includes means for separating billing information corresponding to individual recipients.

15. A billing system as recited in claim 12 further including an inserter system coupled to said printer.
16. A billing system as recited in claim 12 wherein the electronic information server includes means for determining whether or not a said recipient has retrieved a transmitted electronic billing statement.
17. A billing system as recited in claim 12 further including means for electronically transmitting funds from said at least one recipient to said biller.
18. A method for delivering billing statements from a biller to a recipient by means of a printed transmission or electronic transmission, comprising the steps of:
generate billing information for at least one recipient from a biller's computer;
prescribing delivery preferences for said billing information;
associating said delivery preferences with said billing information to determine if said billing information is to be transmitted via printed transmission or electronic transmission;
generating a printed billing statement from said billing information if said billing information was determined to be transmitted via printed transmission;
converting said billing information for electronic transmission if said billing information was determined to be transmitted via electronic transmission; and
generating an electronic billing statement from said converted billing information if said billing information was determined to be transmitted via electronic transmission.
19. A method for delivering billing statements as recited in claim 18 further including the step of providing said delivery preferences in a database separate from said biller's computer for generating said billing information.
20. A method for delivering billing statements as recited in claim 18 further including the step of electronically transmitting funds from said at least one recipient to said biller.

21. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, an apparatus for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

means for accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients and each said record not containing the prescribed delivery preference of the corresponding recipient;

means for isolating each said record from said billing information;

means for extracting from a database the prescribed delivery preference corresponding to each said isolated record;

means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;

means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information;

means for electronically transmitting said electronic billing statement to at least one of said recipients over a communications network; and

means for routing to said printer the records determined to be intended for printed transmission and to said converting and generating means the records determined to be intended for electronic transmission.

22. An apparatus according to claim 21, wherein said prescribed delivery preferences are stored in said database prior to the generation of said billing information.

23. An apparatus according to claim 21, further comprising an inserter system coupled to said printer.

24. An apparatus according to claim 21, further comprising means for determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

25. An apparatus according to claim 21, further comprising means for electronically transmitting funds from said recipients to a biller for whom said billing information is generated.

26. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, a method for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

- accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients and each said record not containing the prescribed delivery preference of the corresponding recipient;

- isolating each said record from said billing information;

- extracting from a database the prescribed delivery preference corresponding to each said isolated record;

- determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon said extracted prescribed delivery preference;

- converting the records determined to be intended for electronic transmission to a format appropriate for electronic transmission and generating an electronic billing statement from the converted records;

- electronically transmitting said electronic billing statements to the corresponding recipients over a communications network; and

routing to said printer the records determined to be intended for printed transmission.

27. A method according to claim 26, further comprising storing the prescribed delivery preferences in said database prior to the generation of said billing information.

28. A method according to claim 26, further comprising determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

29. A method according to claim 26, further comprising electronically transmitting funds from said recipients to a biller for whom said billing information is generated.

30. In a billing system having a computer operative to generate billing information for a plurality of recipients and to communicate said billing information to a printer operative to generate printed billing statements from said billing information, an apparatus for delivering billing statements to the plurality of recipients by one of printed transmission or electronic transmission based upon a prescribed delivery preference of each said recipient, comprising:

a switch for accessing said billing information prior to said billing information being communicated to said printer, said billing information comprising a plurality of records, each record corresponding to one of said recipients; and

a server coupled to said switch, said server comprising:

means for determining whether each of said records is intended for printed transmission or electronic transmission in dependence upon the prescribed delivery preference of the corresponding recipient;

means for converting billing information to a format appropriate for electronic transmission and generating an electronic billing statement from the billing information;

means for electronically transmitting said electronic billing statement to at least one of said recipients over a communications network; and

means for routing to said printer the records determined to be intended for printed transmission and to said converting and generating means the records determined to be intended for electronic transmission;

wherein said switch routes all of said records to said printer if said server fails or is taken out of service.

31. An apparatus according to claim 30, said server further comprising means for isolating each said record from said billing information.

32. An apparatus according to claim 31, said server further comprising means for extracting from a database the prescribed delivery preference corresponding to each said isolated record.

33. An apparatus according to claim 31, said server further comprising means for sanitizing each of said records.

34. An apparatus according to claim 30, further comprising an inserter system coupled to said printer.

35. An apparatus according to claim 30, said server further comprising means for determining whether said recipients to whom electronic billing statements have been electronically transmitted have retrieved said electronic billing statements.

36. An apparatus according to claim 30, further comprising means for electronically transmitting funds from said recipients to a biller for whom said billing information is generated.